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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/643,866

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Leigh T. Canham

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NIXON & VANDERHYE, PC

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EXAMINER

ALSTRUM ACEVEDO, JAMES HENRY

ART UNIT

PAPER NUMBER

1616

MAIL DATE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/643,866	Applicant(s) CANHAM, LEIGH T.	
	Examiner James H. Alstrum-Acevedo	Art Unit 1616	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 August 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 46-85 is/are pending in the application.
- 4a) Of the above claim(s) 49-85 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 46-48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>6/11/07</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

**Claims 46-85 are pending.** Claim 86 has been cancelled. Claims 70, 74-80, and 82-85 are withdrawn from consideration as being drawn to non-elected invention. Claims 49-69, 71-73, and 81 are withdrawn from consideration as being drawn to a non-elected species. **Claims 46-48 are under consideration in the instant office action.** Receipt and consideration of Applicants' new IDS (submitted 6/11/07), certified copy of the GB 951596.2 (submitted 9/18/07), remarks/arguments, and amended claim set submitted on August 2, 2007 are acknowledged.

### ***Election/Restrictions***

Applicant's election of Group I (claims 46-69, 71-73, 81, and 86) in the reply filed on November 27, 2006 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, **the election has been treated as an election without traverse** (MPEP § 818.03(a)).

**The requirement is still deemed proper and is therefore made FINAL.**

This application contains claims 70, 74-80, and 82-85 drawn to an invention nonelected with traverse in the reply filed on November 27, 2006. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

*Priority*

Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copies of GB 9524242.6 and GB 9611437.6 have been filed in parent Application Nos. 09/000,258 (now U.S. Patent No. 6,322,895), 09/964,361 (now U.S. Patent No. 6,666,214), and PCT/GB96/01863), filed on 01/30/1998, 09/28/2001, and 08/01/1996, respectively.

Acknowledgment is made of applicant's claim for foreign priority based on an application filed in the United Kingdom on August 3, 1995. It is noted, however, that applicant has not filed a certified copy of the GB 9515956.3 application as required by 35 U.S.C. 119(b). The Examiner has reviewed the parent applications and priority document, **GB 9515956.3, filed August 3, 1995 in the United Kingdom was not in any of the parent files.**

Receipt is acknowledged of a certified copy of the GB 951596.2 application. However, GB 951596.2 is **NOT referred to in the oath or declaration or in an application data sheet.** If this copy is being filed to obtain the benefits of the foreign filing date under 35 U.S.C. 119(a)-(d), applicant should also file a claim for such priority as required by 35 U.S.C. 119(b). If the application being examined is an original application filed under 35 U.S.C. 111(a) (other than a design application) on or after November 29, 2000, the claim for priority must be presented during the pendency of the application, and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior foreign application. See 37 CFR 1.55(a)(1)(i). If the application being examined has entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the claim for priority must be made during the pendency of the application and

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within the time limit set forth in the PCT and Regulations of the PCT. See 37 CFR 1.55(a)(1)(ii). Any claim for priority under 35 U.S.C. 119(a)-(d) or (f) or 365(a) or (b) not presented within the time period set forth in 37 CFR 1.55(a)(1) is considered to have been waived. If a claim for foreign priority is presented after the time period set forth in 37 CFR 1.55(a)(1), the claim may be accepted if the claim properly identifies the prior foreign application and is accompanied by a grantable petition to accept an unintentionally delayed claim for priority. See 37 CFR 1.55(c).

***Moot Rejections/objections***

All rejections and/or objections of claim 86 cited in the previous office action mailed on March 6, 2007 **are moot**, because said claim has been cancelled.

***Specification***

The objection to the disclosure because of the informalities and the improper use of trademarks cited in the office action mailed on March 6, 2007 is withdrawn per Applicants amendments to the specification correcting the informalities and capitalizing the THERMCO® trademark in paragraph [0091].

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The rejection of claims 46-48 under 35 U.S.C. 101 because the claimed invention is not supported by either a specific or substantial asserted utility or a well-established utility is withdrawn per Applicants' claim amendments.

***Response to Arguments***

Applicant's arguments, see page 9, filed August 2, 2007, with respect to the rejection of claims 46-48 under 35 U.S.C. 101 have been fully considered and are persuasive. The rejection of claims 46-48 under 35 U.S.C. 101 has been withdrawn.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The rejection of claims 46-48 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement is maintained for the reasons of record set forth in the office action mailed on March 6, 2007.

***Response to Arguments***

Applicant's arguments filed August 2, 2007 have been fully considered but they are not persuasive. Applicants' traversal is based on their belief that the claim amendments have overcome the instant rejection. The Examiner respectfully disagrees. Amendment of the preamble of the rejection claims to recite, "A method of facilitating the growth of natural host

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tissue...” does not cure the lack of adequate written description for the step of implanting a sample of resorbable porous silicon into a living animal or human as was described in the office action mailed on March 6, 2007. Thus, this rejection remains proper.

### *Claim Rejections - 35 USC § 102*

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The rejection of claims 46-48 under 35 U.S.C. 102(b) as being anticipated by Wolfrom et al. (U.S. Patent No. 4,326,523) **is withdrawn** upon further consideration and per Applicants' persuasive arguments.

### *Response to Arguments*

Applicant's arguments, see page 10, filed August 2, 2007, with respect to the rejection of claims 46-48 under 35 U.S.C. 102(b) as being anticipated by Wolfrom et al. (U.S. Patent No. 4,326,523) have been fully considered and are persuasive. The rejection of claims 46-48 under 35 U.S.C. 102(b) as being anticipated by Wolfrom et al. (U.S. Patent No. 4,326,523) has been withdrawn.

### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re*

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*Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

The rejection of claims 46 and 48 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3 and 6 of U.S. Patent No. 6,666,214 (USPN '214) **is maintained** for the reasons of record and because Applicants have not provided any substantive arguments traversing the instant rejection.

The provisional rejection of claim 46 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 91-92 of copending Application No. 11/159,340 (copending '340) **is maintained** for the reasons of record and because Applicants have not provided any substantive arguments traversing the instant rejection.

### *Conclusion*

**Claims 46-48 (i.e. all claims under consideration in the instant office action) are rejected. No claims are allowed.**

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).



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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H. Alstrum-Acevedo whose telephone number is (571) 272-5548. The examiner can normally be reached on M-F, 9:00-6:30, with every other Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on (571) 272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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